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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of:

Clemens SCHMICK et al.

Appl. No. 09/785,508

Filed: February 20, 2001

Art Unit: 1731

Examiner: Carlos N. Lopez

Atty. Docket No. 31512-168975

For: APPARATUS FOR
TRANSPORTING STREAMS OF
TOBACCO PARTICLES AND THE
LIKE

Customer No.



26694

PATENT TRADEMARK OFFICE

**PETITION TO THE COMMISSIONER UNDER 37 C.F.R. §1.181 TO
WITHDRAW THE FINALITY OF A PREMATURE FINAL REJECTION**

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition the Commission to withdraw the finality of the rejections in the Office Action mailed May 6, 2003.

MPEP §706.07(a) states: "Under present practice, second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicants' amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. §1.97(c) with fee set forth in 37 C.F.R. §1.17(p)." (emphasis added)

In the present application, the Examiner set forth new grounds of rejection for of the claims in the Action dated May 6, 2003, the second action on the merits, and made the rejection final. On page 6 of the Action, the Examiner states that "Applicant's amendment necessitated

the new ground(s) of rejection presented in the Office action.” Reconsideration is respectfully requested.

The Amendment filed February 19, 2003 did not necessitate a new ground of rejection.

Claims 1 and 8 were rewritten as new independent claim 22. Claim 8 was directly dependent from claim 1 and was rewritten verbatim in independent form as claim 22. In that claim 8 was already considered by the Examiner in the previous rejection, the addition of this claim in independent form could not “necessitate” the new rejection. (It is furthermore noted that the only other amendments made in the Amendment filed February 19, 2003 were rewriting allowable claims in independent and changing the dependency of the dependent claims to new independent claim 22.)

For the convenience of the Commissioner, claims 1, 8 and 22 are listed below to demonstrate that claim 22 did not require new consideration on the part of the Examiner.

Claim 1. (original) Apparatus for transporting a stream of particulate material,
comprising:

a channel having elongated walls defining a stream-receiving and guiding path, at least
one of said walls being movable lengthwise and having a stream-contacting surface provided
with material-receiving recess; and

means for moving said at least one wall.

Claim 8. (original) The apparatus of claim 1, wherein said means for moving includes a
rotary pulley and a digital servo drive for said pulley.

Claim 22 (re-presented – formerly dependent claim 8) Apparatus for transporting a
stream of particulate material, comprising:

a channel having elongated walls defining a stream-receiving and guiding path, at least
one of said walls being movable lengthwise and having a stream-contacting surface provided
with material-receiving recesses; and

means for moving said at least one wall, said means for moving including a rotary pulley
and a digital servo drive for said pulley.

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From a comparison of the claims above, it is clear that the addition of claim 22 did not necessitate the new grounds of rejection. As such, withdrawal of the finality of the rejection is respectfully requested.

Although no fee is believed due, the Patent Office is hereby authorized to charge any fee necessitated by this petition to Deposit Account No. 22-0261.

Respectfully submitted,

Date: 05/13/03



Chad C. Anderson
Registration No. 44,505
VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 962-4800
Telefax: (202) 962-8300